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EXAMINER

GATES, ERIC ANDREW

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/757,660
Filing Date: January 14, 2004
Appellant(s): ALLEMANN ET AL.

Roger D. Greer

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 October 2008 appealing from the Office action mailed 5 May 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Appellant's statement "Whether the §103(a) rejection of Claim 11 over Crutchfield in view of Peot and further in view of Von Hollen should be reversed" should instead read "Whether the §103(a) rejection of Claim

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11 over Crutchfield in view of Von Hollen should be reversed", as the rejection of claim 11 did not rely upon Peot.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,866,319	CRUTCHFIELD	9-1989
3,640,635	VON HOLLEN	2-1972

Webster's Online Dictionary Definition of "Switch"

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 10, and 12 stand rejected under 35 U.S.C. 102(b) as being anticipated by Crutchfield (U.S. Patent 4,866,319).

Regarding claim 1, Crutchfield discloses a control mechanism 28/66/76 for a rotary hand tool 10 having a generally cylindrical housing 12 in which a drive motor 26 is located, the housing having a generally tapered nose portion 14 at an end from which a motor output shaft 24 extends (see figure 2, shaft 24 extends (primary definition "to stretch out", per Oxford online dictionary) from motor 26 in the nose portion) and a grip portion 14 around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism 28/66/74 being a part

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of the tool and located substantially within the housing thereof and comprising: an electrical control circuit 74 contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor; and a light touch switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78) having at least a first position (not pushed) and a second position (pushed) (see column 4, lines 46-68) coupled to said electrical control circuit (mechanically coupled through contact with microswitch 78) for selectively enabling or disabling said control circuit to turn the motor on and off, wherein said motor current does not flow through said switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78); wherein said switch 30 is disposed on the tapered nose portion 14 of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

Regarding claim 2, Crutchfield discloses wherein said switch 30 is configured to be generally rectangular (exterior portion 88 as viewed from above in figure 1).

Regarding claim 3, Crutchfield discloses wherein said switch 30 has a predetermined thickness (it is inherent that the switch would be made with a predetermined thickness).

Regarding claim 4, Crutchfield discloses wherein said first position disables said electrical control circuit and said second position enables said electrical control circuit (see column 3, lines 41-48).

Regarding claim 5, Crutchfield discloses wherein the tapered nose portion on which said switch 30 is disposed generally corresponds to a location of the operator's index finger when grasping the tool (see figure 1).

Regarding claim 10, Crutchfield discloses an apparatus 28 for selectively controlling power applied to and the operation of the motor 26 of a rotary hand tool 10 having a generally cylindrical housing 12 that includes a generally tapered nose portion 14 that has a gradually reduced circumference toward an end from which an output shaft 24 extends (see figure 2, shaft extends (definition "to stretch out", per Webster's online dictionary)), and a grip portion 14 around which an operator wraps a hand during operation of the tool, said apparatus comprising: electrical control circuitry 28/66/74 for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing; a switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78) having a switch button 88 and containing at least a pair of switch contacts 80/86 that are selectively opened and closed responsive to actuation of said switch button 88, said switch 30 being operatively connected to said control circuitry to control the operation of the motor (switch 30 is mechanically connected to the control circuitry through contact with microswitch 78), including the application of motor current to the motor, wherein said motor current does not flow through said switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78), said switch 30 being a part of the tool 10 and located substantially within the tapered nose portion 14 thereof; and a cavity (see figure 2) disposed in the

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nose portion of the tool that is configured to receive at least a portion of said switch 30 and permit actuation of said switch button 88.

Regarding claim 12, Crutchfield discloses that the outer surface of said switch button 88 is generally coextensive with the outer surface of said nose portion 14 (see figure 1).

Claims 6-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Von Hollen (U.S. Patent 3,640,635).

Regarding claim 6, Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of flexible grip material surrounding at least a portion of the nose portion.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the nose portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

Regarding claims 7-9, the modified invention of Crutchfield discloses the invention substantially as claimed.

Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Von Hollen (U.S. Patent 3,640,635).

Regarding claim 11, Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of grip material surrounding at least a portion of the grip portion in which said switch is located.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the grip portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

(10) Response to Argument

Appellant's arguments filed on 8 October 2008 have been fully considered, but they are not persuasive.

Appellant argues on page 9, regarding the rejection of claim 1, that "the examiner has now explicitly redefined the switch 30 as only including the switch button device 30 and not the electrical elements of microswitch 78. This redefinition is an egregious mischaracterization of the Crutchfield switch and is contrary to the language of the specification itself". The Examiner has based this "redefinition" of the term "switch" on the Webster's Online Dictionary definition of "switch", definition 5, which states that a

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switch is “a device for making, breaking, or changing the connections in an electrical circuit”. This definition and the claim language do not require that the switch be a part of the electrical linkage, and as such the mechanical switch 30 of Crutchfield meets the requirements of the claim. Appellant's arguments state that the switch button device 30 is just a mechanical linkage, but they do not state how the claim language does not allow for this interpretation. Furthermore, as set forth in MPEP 2111.01 [R-5], “During examination, the claims must be interpreted as broadly as their terms reasonably allow...This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification”. Appellant's specification does clearly state that the term “switch” means a device that must include electrical as well as mechanical elements.

Appellant argues on page 12, regarding the rejection of claim 10, that “This whole discussion is believed to be irrelevant for the reason that applicant has specifically claimed the switch as having a switch button and a pair of switch contacts”. However, it is noted that the exact claim language of claim 10 is “a switch having a switch button and *containing* at least a pair of switch contacts”. Elements 86 and 80 of Crutchfield were set forth in the rejection as the switch contacts for switch 30. Element 86 is the ring-like portion of switch 30, and element 80 is the protruding activating button of microswitch device 78. It is clear from figure 2 and page 4, lines 40-45 of Crutchfield, that element 80 is *contained* within the ring-like element 86 of switch 30. Furthermore, elements 30, 86, and 80 are mechanical linkages which do not support motor current; therefore, these elements also meet this requirement of the claim.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Eric A. Gates/

Examiner, Art Unit 3726

Conferees:

/DAVID P. BRYANT/

Supervisory Patent Examiner, Art Unit 3726

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